



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,304	06/29/2001	Rod Ross	155615-0024	2393

1622 7590 09/27/2002

IRELL & MANELLA LLP
840 NEWPORT CENTER DRIVE
SUITE 400
NEWPORT BEACH, CA 92660

EXAMINER

WEBB, SARAH K

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,304

Applicant(s)

ROSS ET AL.

Examiner

Sarah K Webb

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 32-44, 46, 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-31 and 45, drawn to a blade assembly, classified in class 606, subclass 166.
 - II. Claims 32-39, drawn to blade assembly tool, classified in class 606, subclass 167.
 - III. Claim 40, drawn to method for assembling a blade assembly, classified in class 606, subclass 167.
 - IV. Claims 41-43, drawn to a blade package, classified in class 606, subclass 172.
 - V. Claim 44, drawn to a gauge, classified in class, subclass 172.
 - VI. Claim 46, drawn to a caliper, classified in class 606, subclass 4.
 - VII. Claim 47, drawn to a method of measuring a corneal flap, classified in class 606, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the blade assembly can be assembled by tools other than the tool claimed.
3. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the method for assembling the blade assembly does not require use of the assembly tool.

4. Inventions I, IV, and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions IV and V have separate utility such as being used with various other types of tools rather than the claimed blade assembly. See MPEP § 806.05(d).

5. Inventions II, IV, V, VI and VII are all unrelated to one another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions can be used with various other types of equipment and for different purposes. For example, the assembly tool has a totally different function than the caliper, so they can be used separately.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Ben Yorks on September 12, 2002 a provisional election was made without traverse to prosecute the invention of Group I, the blade assembly, claims 1-31 and 45. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 32-44, 46, and 47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

9. The abstract of the disclosure is objected to because a word is missing before “hole” in line 1 of page 38. Examiner also suggests changing the abstract to only describe the elected invention. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-20, 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,759,363 to Jensen.

Jensen anticipates all the limitations of the claims. A scalpel (10) has blade (18) with cutting edge (22), and a guard (38) is rearwardly coupled to the blade (Figure 1A and B). The guard defines a depth of cut for the blade (column 2, line 37) and has an inclined, or raised, front surface. Jensen explains that the guards may be color coded in

order to define different cutting depths (column 6, line 20). As shown in Figure 1A, the depth of cut (B) is dependent upon a dimension from the front surface of the guard tip (62). As most clearly illustrated in Figure 5, the guard includes a plurality of pockets (44). The guard further includes a slot (42), which is also considered a recess or hole, and a notch (76). These holes are capable of receiving bonding agents.

11. Claims 21-26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,938,676 to Cohn et al.

The surgical instrument of Cohn includes a blade (12) with a blade holder (20) attached at the blade's rear edge. As shown in Figure 2B, the blade holder (20) includes a slot (26), or recess, and a channel (30), or hole. Cohn explains that the blade may be attached to the blade holder by adhesive bonding (column 7, line 46). Figure 24 illustrates the plurality of raised surfaces of the blade holder (320).

12. Claim 45 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,651,782 to Simon et al.

Figure 2 of Simon illustrates the limitations of the claim, including a blade (12), blade holder (16), and an opening (18) between the cutting edge (22) and the blade holder.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent No. 5,690, 658 to McAdams – blade holder that limits depth of cut into cornea; includes color as indicator of fixed depth
- U.S. Patent No. 3,945,117 to Beaver – guard that limits depth of cut attached to blade

- U.S. Patent No. 6,051,009 to Hellencamp – Microkeratome disposable cutting blade assembly
- U.S. Patent No. 5,224,950 to Prywes – color-coded intraocular cutting blade
- U.S. Patent No. 5,819,628 to Cogan et al.- blade holder with plurality of recesses, holes, and raised surfaces


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (703) 305-7554. The examiner can normally be reached on 8am-4:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Sarah K Webb
Examiner
Art Unit 3731

SW
September 16, 2002


Michael Milano
Supervisory Patent Examiner
Art Unit 3700